



Image

Docket 83598KNM  
Customer No. 01333

1762

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE**

In re Application of:  
Jeffrey W. Leon, et al

SUBSTRATE FOR PROTEIN  
MICROARRAY CONTAINING  
FUNCTIONALIZED POLYMER

Serial No. 10/091,644

Filed 06 March 2002

Group Art Unit: 1762

Examiner: Nathan M. Nutter

I hereby certify that this correspondence is being deposited today with the United States Postal Service as first class mail in an envelope addressed to Commissioner For Patents, P.O. Box 1450, Alexandria, VA 22313-1450.

Carol A. Kukurudza

Date

Commissioner for Patents  
P.O. Box 1450  
Alexandria, VA. 22313-1450

Transmitted herewith is an amendment in the above-identified application:

- ☒ No additional fee is required.  
☐ The fee has been calculated as shown below:

	(Col. 1)		(Col. 2)	(Col. 3)	OTHER THAN A SMALL ENTITY	
	CLAIMS REMAINING AFTER AMENDMENT		* HIGHEST NO. PREVIOUSLY PAID FOR	PRESENT EXTRA	RATE	ADDITIONAL FEE
TOTAL		MINUS	20	0	X 18	\$0
INDEP		MINUS	3	0	X 86	\$0
FIRST PRESENTATION OF MULTIPLE DEPENDENT CLAIM					+ 290	\$ 0
					<b>TOTAL</b>	<b>\$0</b>

\* The "Highest Number Previously Paid For" (Total or Independent) is the highest number found from the equivalent box in Col. 1 of a prior amendment or the number of claims originally filed.

☐ Please charge my Eastman Kodak Company Deposit Account No. **05-0225** in the amount of \$0.

**A duplicate copy of this sheet is enclosed**

☒ The Commissioner is hereby authorized to charge payment of the following fees associated with this communication or credit any overpayment to Eastman Kodak Company Deposit Account No. **05-0225**

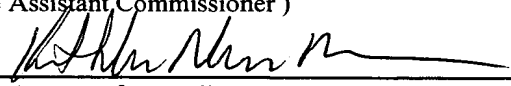
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☒ Any additional filing fees required under 37 CFR 1.16.

☒ Any patent application processing fees under 37 CFR 1.17.

(For Extensions of Time and other Petitions to the Assistant Commissioner)

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Attorney for Applicants  
Registration No. 40,101



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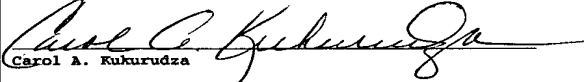
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Carol A. Kukurudza  
March 16, 2004  
Date

Sir:

**RESPONSE TO RESTRICTION REQUIREMENT**

In response to the Office Action issued March 1, 2004, Applicants provide the following comments:

A Restriction Requirement has been made requiring election of one of Groups I-IV as follows:

- I: Claim 1 and Claims 3, 7, 14, 19-22, and 24 as they depend from claim 1, drawn to a gelatin based substrate;
- II: Claim 2 and Claims 3-24 as they depend from claim 2, drawn to a gelatin based substrate;
- III: Claim 25, drawn to a method of making the substrate of Group II; and
- V: Claims 26-29, drawn to a method of making the substrate of Group II.

Applicants traverse the rejection for at least the following reasons.

The Office Action states at page 1 that the inventions of Groups I and II are distinct because "they are not capable of use together and they have

different modes of operation, different functions, or different effects.” However, the inventions of Groups I and II are both a gelatin-based substrate including a substrate having gelatin on at least one surface and a polymer scaffold affixed to the gelatin surface, and wherein both groups require one or more reactive units capable of interacting with a protein or a protein capture agent. There is significant overlap in the fields of search, as evidenced by the Examiner’s recitation of appropriate search fields, which search fields are **identical** for Groups I and II (see below).

The Office Action states at page 2 that the inventions of Groups III and IV are distinct because “they are not capable of use together and they have different modes of operation, different functions, or different effects” and have “different steps.” However, the inventions of Groups III and IV are both a method of making a gelatin-based substrate including providing a support, coating on the support a composition including gelatin, affixing a polymer scaffold to a surface of the gelatin, wherein both polymer scaffolds have or interact with one or more reactive units capable of interacting with a protein or a protein capture agent. There is significant overlap in the features, and therefore in the fields of search, as evidenced by the Examiner’s recitation of appropriate search fields, which search fields are **identical** for Groups III and IV (see below).

The Office Action states at page 2 that the inventions of Groups I and III are related, but distinct because “the process can be used to make other and materially different substrates.” However, the process of claim 25 (Group III) reads as steps for putting together the exact features of claim 1 (Group I). The process of claim 25 requires each and every element of the product of claim 1, and therefore necessarily results in at least the product of claim 1. Because the product of claim 1 (Group I) is included within the process of claim 25 (Group III), there is significant overlap in the search field that would place no undue burden on the Examiner.

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The Office Action states at page 3 that the inventions of Groups II and IV are related, but distinct because “the process can be used to make other and materially different substrates.” However, the process of claim 26 (Group IV) reads as steps for putting together the exact features of claim 2 (Group II). The process of claim 26 requires each and every element of the product of claim 2, and therefore necessarily results in at least the product of claim 2. Because the product of claim 2 (Group II) is included within the process of claim 26 (Group IV), there is significant overlap in the search field that would place no undue burden on the Examiner.

The Examiner asserts at page 4 the inventions of all Groups I-IV “are distinct . . . and have acquired a separate status in the art as shown by their *different classification*” (emphasis added). However, as shown by the excerpt below from page 1 of the Office Action, all of Groups I-IV share the same fields of search: class 428, subclass 478.2; class 435, subclass 960; and class 436, subclasses 528, and 809. Additional fields of search indicated are class 435, subclasses 180 (Groups I and III) and 181 (Groups II and IV), and class 436, subclasses 531 (Groups I and III) and 532 (Groups II and IV).

- I. Claims 1, 3/1, 7/1, 14/1, 19/1-22/1 and 24/1, drawn to a gelatin-based substrate, classified in class 428, subclass 478.2, class 435, subclasses 180 and 960, and class 436, subclasses 528, 531 and 809.
- II. Claims 2, 3/2, 4-6, 7/2, 8-13, 14/2, 15-18, 19/2-22/2, 23 and 24/2, drawn to a gelatin-based substrate, classified in class 428, subclass 478.2, class 435, subclasses 181 and 960, and class 436, subclasses 528, 532 and 809.
- III. Claim 25, drawn to a method of making the substrate of Group I, classified in class 428, subclass 478.2, class 435, subclasses 180 and 960, and class 436, subclasses 528, 531 and 809.
- IV. Claims 26-29, drawn to a method of making the substrate of Group II, classified in class 428, subclass 478.2, class 435, subclasses 181 and 960, and class 436, subclasses 528, 532 and 809.

Thus, examination of all of Groups I-IV places no additional burden on the Examiner.

In compliance with the Restriction Requirement, Applicants elect Group 2, Claim 2 and Claims 3-24 as they depend from claim 2, drawn to a gelatin based substrate for prosecution, with traverse as stated above. For at least the reasons set forth herein, withdrawal of the rejection is proper, and such withdrawal and examination of all claims is earnestly solicited.

#### **Information Disclosure Statement**

Applicants note the Examiner did not acknowledge consideration of the P. I. Rose reference submitted in the Information Disclosure Statement and Form PTO-1449 filed June 11, 2002, because the Examiner was unable to determine the date of the reference. Applicants attach hereto a copy of the PTO-1449 and the reference, including the title page and copyright page, for the Examiner's consideration.

Should the Examiner have any questions, or require anything further, he is invited to contact Applicants undersigned representative.

Respectfully submitted,

A handwritten signature in black ink, appearing to read 'Kathleen Neuner Manne', is written over a horizontal line.

Kathleen Neuner Manne/cak  
Telephone: 585-722-9225  
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Attorney for Applicants  
Registration No. 40,101

Attachment: Copy of Form PTO-1449 filed June 11, 2002 and Rose reference